

Application No. 10/816766  
Reply to Office Action of March 27, 2006

Docket No.: 05129-00079-US

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### REMARKS

Applicant respectfully requests reconsideration in view of the amendment and following remarks. Support for newly amended claim 15 can be found in the specification at page 5. Support for newly added claims 41 and 42 can be found in the specification at page 2, lines 29-33. No additional fee is required for these claims.

### Comments to the Interview

The applicant thanks the Examiner for permitting the applicant to conduct an interview on September 12, 2006. The applicant discussed broadening claim 15 and stated that it was believed to be patentable over Michaud (US Patent 5,973,055). The applicant also discussed that the applicant believed that Nalewajek et al. U.S. Patent No. 6,355,113 ("Nalewajek") did not rendered the applicant's claimed invention obvious and in fact, taught away from the applicant's claimed invention for the reasons discussed below.

Claims 12-14, 18, 19 and 24-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nalewajek. The applicant respectfully traverses this rejection for the following reasons.

Nalewajek discloses hundreds of isomers according to its invention (see cols. 8 through 15). However, as recognized by the Examiner the specific isomer of 1,1,1,3,3-pentafluorobutane is not disclosed. The applicant's claimed isomer of 1,1,1,3,3-pentafluorobutane is flammable (see page 1, lines 16-18 of the specification).

In addition, Nalewajek teaches away from the applicant's claimed invention. Nalewajek states at col. 4, lines 1-8,

In one embodiment, the cleaning can be done in a system where a solution of the hydrocarbon solvent and the fluorocarbon solvent is mixed together

Application No. 10/816766  
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Docket No.: 05129-00079-US

optionally with a surfactant as a solubilizing agent in a degreaser. The fluorocarbon, being more volatile, provides a flammability suppression blanket. The same fluorocarbon would be used in the adjacent rinse sump for an initial immersion or spray liquid rinse followed by a final rinse in the vapor. (emphasis added).

Nalewajek is teaching that the fluorocarbon is flame retardant and not flammable as is required by the applicant's claimed invention.

Furthermore, the applicant's claimed invention requires more than 5 % of weight of at least one non-flammable fluoro compound (see independent claim 12). The examples of Nalewajek do not have at least 5 % of weight of at least one non-flammable fluoro compound. The examples have substantially a lower amount. There is no teaching in Nalewajek to have more than 5 % of weight of at least one non-flammable fluoro compound as is required by the applicant's claimed invention.

The Examiner must consider the reference as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless the prior art suggested the desirability of such modification (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35

Application No. 10/816766  
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Docket No.: 05129-00079-US

U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction. For the above reasons, this rejection should be withdrawn.

With respect to the broadening of claim 15, Michaud discloses at col. 6, lines 53-63:

The fluorinated hydrocarbon chosen from the compounds cited above, and in particular the compound of formula (III) may be used alone or in a mixture with one or more other compounds chosen for example from the partially fluorinated inferior alkanes, glycol ethers, silicone oils of low molecular weight and methoxypropanol.

Preferably, monoalkyl ethers of alkylene glycols are used such as the monomethyl ether of dipropylene glycol available from ARCO under the name ARCOSOLV®DPM or the mono(n)butyl ether of dipropylene glycol also called DPnB (dipropylene glycol mono(n)butyl ether).

The applicant believes that claim 15 as amended is not anticipated or rendered obvious over Marchaud.

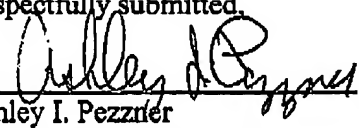
In view of the above amendment, applicant believes the pending application is in condition for allowance.

Application No. 10/816766  
Reply to Office Action of March 27, 2006

Docket No.: 05129-00079-US

A three month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05129-00079-US from which the undersigned is authorized to draw.

Respectfully submitted,

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